

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 38

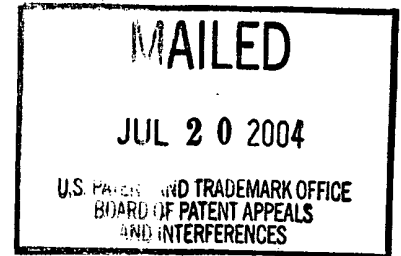
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD L. CARR

Appeal No. 2004-0884
Application No. 08/952,001

ON BRIEF



Before PAK, KRATZ and DELMENDO, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 55 and 85. Claims 56-58, 60-62, 66-69, 73-78, 82-84 and 88-92 were indicated to be allowable by the examiner. Claims 59, 63-65, 70-72, 79-81, 86 and 87 which are the only other claims pending in this application, were objected to by the examiner as depending on a rejected base claim.

BACKGROUND

Appellant's invention relates to a gasket for sealing a pair of pipe flanges. A further understanding of the invention can be

derived from a reading of exemplary claim 55, which is reproduced below.

55. A gasket for providing a seal at the joint between a pair of pipe flanges for connecting one flange to the other, comprising:

a first strip of a material that is adapted for sealing and formed in a loop and having an outer periphery;

a second strip of said sealing material formed in a loop and having an inner periphery that is greater than the outer periphery of said first strip; and

at least one spoke of said sealing material extending between said first strip and said second strip wherein remaining spaces therebetween are substantially void.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Merwarth	Re 11,858	Sep. 25, 1900
Mastin	1,245,002	Oct. 30, 1917

Claim 55 stands rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being unpatentable over Merwarth. Claim 85 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mastin.

We refer to the briefs and to the answer for a complete exposition of the opposing viewpoints expressed by appellant and the examiner concerning the issues before us on this appeal.

OPINION

Having carefully considered each of appellants' arguments set forth in the brief and reply brief, appellants have not persuaded us of reversible error on the part of the examiner with respect to the § 103(a) rejections advanced by the examiner. However, we agree with appellant's position with regard to the § 102(b) rejection. Accordingly, we affirm the examiner's § 103(a) rejections but we reverse the examiner's § 102(b) rejection. Our reasoning follows.

Rejection under 35 U.S.C. § 102(b)

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); accord Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995).

The examiner does not refer us to any part of Merwarth that expressly describes the contested limitation, "said sealing material" (claim 55), which requires that the identical sealing material is used for the first and second strips of material and for spokes used in the gasket. Rather, the examiner argues that the "soft metal" employed in the Figure 3 embodiment of Merwarth for forming a first strip (A), a second strip (F) and a spoke

(element C) inherently results in the use of the same soft metal for each.

A central question before us is whether the examiner's assertion of inherency with respect to the Merwarth reference is reasonable. We answer that question in the negative because the examiner has not provided a sufficient basis in fact and/or technical reasoning to reasonably support the examiner's assertion (answer, pages 4 and 6) concerning the allegedly inherent description of the same soft metal for each of the specified component parts of the gasket of figure 3 of Merwarth as necessarily flowing from the teachings of the applied prior art. While the examiner argues, in effect, that there is no disclosure in Merwarth respecting the Figure 3 embodiment requiring that "the soft metal of C should not be as soft as the soft metal of A" (answer, page 6), there is no explanation on how and why the soft metals of the reference would necessarily satisfy the contested limitation with respect to employing the same material for each strip and the spokes.

The examiner, in relying on a theory of inherency, must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the

applied prior art. See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Inherency cannot be established based on probabilities or possibilities. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). The examiner simply has not provided persuasive support for an inherency theory.

Because the examiner has not established a prima facie case of anticipation within the meaning of 35 U.S.C. § 102, we will not affirm the § 102(b) rejection.

§ 103(a) Rejection of claim 55

The examiner's § 103(a) rejection of claim 55 over Merwarth stands on a different footing. Here, the examiner's rejection is not premised on an inherency theory. While picking and choosing may have no place in making a § 102 rejection for anticipation, such can be entirely proper in making an obviousness rejection under § 103. See In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

Appellant does not contest the examiner's position with respect to the correspondence of the gasket of Figure 3 of Merwarth with that called for by appealed claim 55 but for the requirement of using the same material in forming the first and second strips and the spokes of the gasket. Here, the examiner

basically asserts that one of ordinary skill in the art would have been led to select the same soft metal for the elements (C) corresponding to appellant's spokes as for the strip (A) and the strip (F) of the gasket of Figure 3 of Merwarth. According to the examiner, the simplicity (and economy) of using the same source of material for manufacturing those component parts of the gasket of Merwarth would have suggested the selection of the same soft metal material for each part to one of ordinary skill in the art at the time of the invention. After all, Merwarth teaches that each strip and the eyes (spokes) can be made from a soft metal and that each are used for the functional purpose of sealing. See pages 7 and 8 of the answer.

Appellant (supplemental brief, pages 18 and 19) maintains that:

one cannot presume that "easing manufacturing" is sufficient motivation to direct persons of ordinary skill in any art to form parts that were conventionally formed of different materials out of the same materials just to permit integral manufacture.

Moreover, appellant maintains that Merwarth's reference to using "soft metal" (page 2, column 1, lines 27-33) in forming the eyes (C) to effect sealing of the bolt holes does not require that the soft metal used is the same soft metal employed in forming the rings. In appellant's view the soft metals used would be understood by one of ordinary skill in the art as being

different based on the description of the embodiment of Figures 1 and 2 in Merwarth and based on appellant's arguments that an undesirable result would be obtained if the metals were not different. See, e.g., the reply brief¹, pages 3-8.

We agree with the examiner's obviousness conclusion and we do not consider appellant's characterization of the examiner's reasoned position and the thrust of the arguments presented persuasive. While Merwarth teaches that the gasket of the embodiment depicted in Figures 1 and 2 wherein the outer ring (B) can be formed of a harder material than the inner ring (A), we do not conclude, as apparently appellant does, that such a choice of different materials as taught by that embodiment would be viewed by one of ordinary skill in the art as being a required choice for the separate embodiment of Figures 3 and 4 of Merwarth. This is so given that Merwarth specifically teaches that soft metal is used for all of the sealing parts of the gasket of the Figure 3 and 4 embodiment.

While we recognize that Merwarth (Page 1, column 1, lines 42 and 43) indicates that "[letters of like name and kind refer to like parts in each of the figures," the term "like parts" is not

¹ Our references to the reply brief refers to the second reply filed September 29, 2003.

limited to identical parts as appellant seemingly argues. Indeed, appellant (reply brief, page 10) acknowledges that "Merwarth does not indicate whether the materials are the same or not" in the alternative embodiment. We note that motivation can be based on both economic as well as simplicity factors, and need not be expressly mentioned by the prior art. See In re Thompson, 545 F.2d 1290, 1294, 192 USPQ 275, 277 (CCPA 1976); In re Clinton, 527 F.2d 1226, 1229, 188 USPQ 365, 367 (CCPA 1976).

Furthermore, it is not necessary for a finding of obviousness that the prior art reference provides all of the specific reasons for the combination of the teachings thereof as disclosed by appellant. See In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996); In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). It is well settled that a prior art reference may be relied upon for all that it would have reasonably conveyed to one having ordinary skill in the art. Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1847 (Fed. Cir. 1989).

As for appellant's contentions (reply brief, pages 4-8) that the physics of a sealing gasket teaches against the use of the same material for each ring of Merwarth because of reduced sealing pressure, we note that such attorney argument is not

substantiated with experimental or expert opinion evidence. As such, that argument is entitled to little weight. Moreover, "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Here, based on the overall teachings of Merwarth as they would have been understood by one of ordinary skill in the art, there is ample motivation for one of ordinary skill in the art to have selected the same soft metal for the rings A and F and the eyes (C) of the gasket of Merwarth so as to render such a gasket useful for sealing pipes as well as being inexpensive to make as proposed by the examiner. That there exists an option of using different materials for the different gasket parts is clearly not an impediment to using the same materials as another alternative.

Having reconsidered the evidence of record for and against a conclusion of obviousness in light of the respective arguments advanced by appellant and the examiner, it is our determination that, on balance, the evidence weighs most heavily in favor of an obviousness conclusion with respect to the rejection under

consideration.

It follows that we will affirm the examiner's § 103 (a) rejection of claim 55 over Merwarth.

§ 103(a) Rejection of claim 85

Appellant does not dispute the examiner's determination that Mastin discloses a gasket corresponding to the gasket of claim 85 but for the claimed substantially square shape of the outer periphery of the second strip of sealing material. According to the examiner, it would have been obvious to one of ordinary skill in the art to select a shape for the outer periphery of the gasket that corresponds to the claimed shape. We agree.

Concerning this matter, we note that Mastin is directed to a gasket that is to be placed between parts to be sealed. The gasket is designed to include bolt holes (d, Figure 1) that are used for tightening the gasket between opposing parts to be joined. It would have been well within the skill of the art to shape the outer periphery of the gasket of Mastin to coincide with the shape of the outer periphery of the parts to be joined, such as the flanges of pipes². In so doing, we agree with the

² We note that a flange is a projecting portion of a part, such as a pipe, that is used to mate and provide surface area for joining another such part therewith. See pages 459 and 460 of The American College Dictionary (1970).

examiner's position that one of ordinary skill in the art would have found the use of an outer peripheral shape, such as the here claimed shape, to be an obvious expedient notwithstanding appellant's contrary viewpoint.

Appellant argues that the claimed gasket would provide corners usable as handles if the gasket were used with a flange pipe joint that was of a size to allow for protrusion of corners of the gasket therefrom.³ However, we do not find that argument persuasive because it is our view that one of ordinary skill in the art would readily recognize that furnishing a gasket with a periphery that extends beyond a pipe joint edge would provide a piece of the gasket that would be available for grasping. It is well settled that expected beneficial results are evidence of obviousness, not the contrary. See In re Skoner, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975). Moreover, appealed claim 85 is not limited to a gasket and pipe joint combination wherein the gasket periphery extends beyond the periphery of the mating pipe joint surfaces.

Consequently, on this record, we will sustain the examiner's

³ While not disclosed in the specification, that asserted "advantage" is nonetheless argued as part of the record of this appeal.

§ 103 (a) rejection of claim 55 over Mastin.

CONCLUSION

The decision of the examiner to reject claim 55 under 35 U.S.C. § 102(b) as being anticipated by Merwarth is reversed. The decision of the examiner to reject claim 55 under 35 U.S.C. § 103(a) as being unpatentable over Merwarth and to reject claim 85 under 35 U.S.C. § 103(a) as being unpatentable over Mastin is affirmed.

AFFIRMED

BOARD OF PATENT
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PFK/jlb

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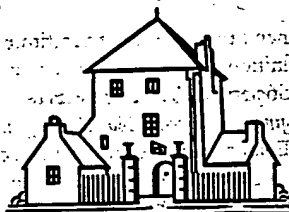
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Act, able, dare, art; Abb, equal; If, ice; hôt, over. ô
ch, chief; g, give; ng, ring; sh, shoe; th, thin;

er, oil, book, 502a, out, tip, 5ae, 5ur, 5e - 5a in alone,
that, 5h, vision. See the full key on inside cover



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